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10/552,322	01/19/2008	Anita Mehta	RLL-313US	2737

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Ranbaxy Inc.
Intellectual Property Department
600 College Road East
PRINCETON, NJ 08540

EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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06/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

general.ip.mailbox@ranbaxy.com

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13,15-16,20-22, drawn to compounds, compositions and use where "C" results in a piperazine ring where Y and Z are as defined except for bridging groups.

Group II, claim(s) 1-8,10-13,15-16,20-22, drawn to compounds, compositions and use where "C" results in a piperidine ring where Y and Z are as defined except for bridging groups.

Group III, claim(s) 1-8,10-13,15-16,20-22, drawn to compounds, compositions and use where "C" results in a pyrrolidine ring where Y and Z are as defined except for bridging groups.

Group IV, claim(s) 1-8,10-13,15-16,20-22, drawn to compounds, compositions and use where "C" results in other cores not provided for- eg. monocyclics such as diazepines, azepines azocines oxazepines, many five-membered rings,4-membered rings as well as spiro-,ortho- and perifused rings.

Group V, claim(s) 23, drawn to a process of making some of the compounds of the above groups.

Group VI, claim(s) 25, drawn to a process for making thiophenyl/furyl/pyrrolyl-substituted derivatives of the compounds of the above groups.

If IV is elected applicants must pick a particular "C" ring as was done for I-III.

If Group V or VI is elected applicants must select a particular "C" ring.

In addition to an election of one of the above groups, applicants must further elect one

of the following subgroups:

A. T= heterocyclic and substituted derivatives ;

B. T= aryl and substituted aryl.

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Whichever Group/subgroup is elected, applicants must elect a single species to which claim(s) may be limited should generic claims pertaining to the elected subject matter be found not allowable.

REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR 1.475(a), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

Where a single claim defines alternatives of a Markush group, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, is considered met when the alternatives are of a similar nature. When the Markush grouping is for alternatives of chemical compounds, the alternatives are regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity; AND

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(B)(1) a common structure is present, that is, a significant structural element is shared by all of the alternatives; OR

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The phrase "significant structural element is shared by all of the alternatives" refers to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity.

The phrase "recognized class of chemical compounds" means that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

The chemical compounds of **I-IV A-B** are not regarded as being of similar nature because: (1) all the alternatives do not share a common structure and (2) the alternatives do not all belong to a recognized class of chemical compounds. They relate to products of considerable structural dissimilarity in view of the varying "C" ring covering literally hundreds of rings given the number and nature and size of the ring which includes various types of fusion. The sole feature common to these groups, namely the phenyl-substituted-2-oxo-5-oxazolidinyl group, cannot be considered an advance over the art given the many "X" references cited in the international search report directed to various aspects of applicants' embodiments.

Said alternatives are variously classified in classes 540, 544, 546 and 548 based on the nature of at least the "C" and "T" rings which includes a huge variety of ring systems or can simply be reduced to H. Thus there exists no substantial structural feature in common that can be said to provide *a priori* an advance over the art.

Process Groups V and VI are not coextensive with any one compound Group but are

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narrower in scope. In claim 23 see M₁ choice which is narrower than "X" in claim 1 as well as choice "T". In claim 25 the "D" ring is directed to 3 types of heteroaryls. Thus the processes cannot be said to share a special technical feature with any one compound Group.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

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All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

*In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.*

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emily Bernhardt/
Primary Examiner, Art Unit 1624

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